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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/542,506
Filing Date: July 15, 2005
Appellant(s): HOLAHAN, JOHN L.

J. Philip Polster
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/31/10 appealing from the Office action mailed 2/2/10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 39-45 and 57-89 are pending.

Claims 39-45 are rejected.

Claims 57-89 are withdrawn from consideration.

Claims 39-45 are on appeal.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office

action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

3,830,407	WIERLO	8-1974
6,455,090	UZUHASHI ET AL.	9-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims.

102 Rejection

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Wierlo (US Patent No. 3,830,407).

Wierlo discloses an apparatus for mixing thickened substances. The apparatus comprises a dispensing nozzle and a combination agitator-mixer-scraper. In addition, Wierlo discloses that unflavored substances such as ice cream, milkshakes, slush, ice,

or frozen custard flows toward and exit nozzle the substance comes in contact flavored syrup (see entire document, especially, abstract; column 1, lines 6-13; column 2, lines 15-18). The dispensing machine of Wierlo is selectively dispenses a thickened food (ice cream, frozen custard, milkshake, etc.) into the dispensing nozzle (abstract; column 3, lines 16-35). In the detailed description of the drawings, the details of the apparatus disclose that the dispense machine comprises a compressor motor, various storage tank, and optionally, a pump (column 2, lines 24-46). The dispensing machine has a switch mechanism to allow the operator to regulate the amount of food product being dispensed. Thus, both Appellant and Wierlo disclose a process for the production of a homogenous single phase thickened beverage comprising connecting a thickener to a dispensing machine and a switch mechanism for controlling the amount of thickener present.

103 Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission in view of Wierlo (US Patent No. 3,830,407) and in further view of Uzuhashi et al (US Patent No. 6,455,090).

In Appellant's response filed 11/23/09 (page 11, first paragraph), the following admission is made: *"Applicant's assignee sold packets of aqueous thickener concentrate in accordance with the disclosure of its U.S. Patent application 10/485,879 more than one year before the effective filing date of the present application. Therefore, such packaged thickener concentrate is prior art with respect to the present application."* Hence, aqueous liquid thickener concentrates are known in the art.

Wierlo discloses an apparatus for mixing thickened substances. The apparatus comprises a dispensing nozzle and a combination agitator-mixer-scraper. In addition, Wierlo discloses that unflavored substances such as ice cream, milkshakes, slush, ice, or frozen custard flows toward and exit nozzle the substance comes in contact flavored syrup (see entire document, especially, abstract; column 1, lines 6-13; column 2, lines 15-18). The dispensing machine of Wierlo is selectively dispenses a thickened food (ice cream, frozen custard, milkshake, etc.) into the dispensing nozzle (abstract; column 3, lines 16-35). In the detailed description of the drawings, the details of the apparatus disclose that the dispense machine comprises a compressor motor, various storage tank, and optionally, a pump (column 2, lines 24-46). The dispensing machine has a switch mechanism to allow the operator to regulate the amount of food product being dispensed. Thus, both Appellant and Wierlo disclose a process for the production of a

homogenous single phase thickened beverage comprising connecting a thickener to a dispensing machine and a switch mechanism for controlling the amount of thickener present.

Uzuhashi et al disclose a liquid additive thickener/liquid thickening agent comprising a liquid that is prepared by dissolving a thickening agent into water (see entire document, especially, abstract). Uzuhashi et al disclose that in order to improve on the formation of particles when a thickening agent is added to a substance, an additive that can easily impart viscosity to a water containing object or gelate is desirable. Thus, their invention incorporates a liquid additive thickener or a liquid thickening agent which may be added into food to easily thicken it (column 1, lines 37-60). In addition, Uzuhashi et al disclose that when (1) the thickening agent is dissolved in a liquid, it retains its fluidity on mixing (column 2, lines 25-27). Also, it is disclosed that Consumers have various preferences as it relates to viscosity and formation of gels for foods. As a result, highly flexible accommodations are needed to meet the individual's needs. Thus, fresh hand-made foods instead of ready-made items that are mass produced as processed foods are required. In order to impart preferable viscosity, for examples, for items such as dressings that adhere to vegetables and sauces for meat and fish dishes, one has to be able to adjust the viscosity of the various items (column 2, lines 37-65). The liquid thickening substance may be utilized in training and nursing facilities to alter the viscosity of food substances for persons with mastication and deglutition difficulties (columns 2-3, bridging paragraph). Possible thickening agents include guar gum, locust bean gum, xanthan gum, sodium

carboxymethylcellulose, and carrageenan (column 3, lines 31-37). The thickening agents are prepared as a liquid with a low viscosity that enables it to be dissolved in water (column 3, lines 38-40). Figure 2 discloses a liquid thickening agent that comprises xanthan gum. In one embodiment of Uzuhashi et al, it is disclosed that ten parts by weight of arabic gum were dissolved into 85 parts by weight of water to prepare a solution of arabic gum (Note: this solution yields a total of 95 parts by weight). Next, five parts by weight of xanthan gum was added to a solution of arabic gum to prepare a liquid thickening agent (Note: the total parts per weight of the solution is 100 which includes that of the water, arabic gum, and xanthan gum; so, xanthan gum is 5% of the solution). Then, 20 parts by weight of the resultant liquid thickening agent were dissolved into 100 parts by weight of water (Note: the total parts by weight is 120 which includes the thickening agent and the water; so, $5\% (20) = 1$ which is portion of the thickening agent that is xanthan gum; thus, $1/120 = 0.008$. So, $0.008 (100\%) = 0.8\%$) (column 5, lines 5-14). Hence, a skilled artisan would recognize that based upon the teachings of Uzuhashi et al, the xanthan gum is between 1% and 10% of the thickener concentrate and between 0.3% and 1% of the beverage (total solution). Furthermore, Uzuhashi et al disclose that the liquid thickening agent of xanthan gum may be dissolved in milk, consommé soup, salad dressing, and many other items (column 5, lines 15-21).

It would have been obvious to one of ordinary skill in the art to generate a process for the production of a homogeneous thickened beverage comprising connecting a source of aqueous liquid thickener to a dispensing machine for the

following reasons. (1) Appellant admits that packets the aqueous liquid thickener packages are known. Therefore, aqueous liquid thickeners are known in the art and were available to the public more than a year before the effective filing date of the present application. (2) It is well known in the art, as indicated by Wierlo, to have a thickened beverage (i.e., milkshake, frozen custard, ice cream, etc.) in contact (i.e., in connection with) with a dispensing machine. (3) Uzuhashi et al disclose motivation for one to use a dispensing machine. In particular, the document discloses that the viscosity and formulation of gels of food require that the gels be highly flexible commodities rather than uniform commodities. It is required that fresh hand-made foods with strictly selected materials rather than ready-made commodities that are mass produced as processed foods be generated. In addition, it is disclosed that the gel may be used to impart preferable viscosity of a hand-made dressing, for example, so as to adhere to vegetables. Imparting viscosity in sauces for meat and fish dishes, adjusting viscosity of a liquid starch dressing, and imparting viscosity on a fruit sauce are other examples of items that may have an adjusted viscosity. Furthermore, Uzuhashi et al disclose that the liquid active thickener may be utilized in nursing and training facility (see column 2, lines 38-65 and columns 2-3, bridging paragraph). Therefore, since both the thickener and a dispensing machine connected a thickener are well known in the art, one would be motivated to combine the inventions in order to address the issues set forth by Uzuhashi et al. Specifically, Uzuhashi et al discloses why one would be motivated to generate meals made based on an individual's need (i.e., a person in a nursing or training facility having mastication and deglutition difficulties). Thus,

Appellant's admission that the thickener is known and the motivation of Uzuhashi et al to have individualized meals, in combination with a dispensing agent of Wierlo connected to a thickened beverage that may be made to an individual's liking, the skilled artisan would recognize that it is obvious to generate a process of producing a thickened beverage comprising connecting an aqueous liquid thickener to a dispensing machine. Since all of the documents are directed to thickened substances, the references may be considered to be within the same field of endeavor. Thus, the reference teachings are combinable.

112 First Paragraph Rejections

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 39-45: Independent claim 39 contains the phrase 'aqueous liquid thickener'. However, review of the specification indicates that reference is made to an 'aqueous liquid' (see paragraph [0079]), an 'aqueous based beverage' (see paragraph [0016]), and a 'liquid aqueous food' (see paragraph [0029]), not an 'aqueous liquid thickener'. Thus, the phrase is new matter and is not supported by the specification...

As a result, the claims contain new matter and lack written description since the instant application does not sufficiently describe the invention as it relates to the phrase 'aqueous liquid thickener'.

Claims 44 and 45: The claims contain new matter because review of the specification does not set forth the ranges appearing in the claims as amended. The Examiner indicated that one cannot neither arbitrarily select endpoints from a range disclosed in the specification nor create a range. Specifically, in claim 44, an endpoint of 1% is not disclosed in the specification. In regards to claim 45, the range 0.3% and 1% of the beverage are not set forth in the disclosure.

112 Second Paragraph Rejections

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 39-45: The claims as written are ambiguous because independent claim 39 contains the phrase 'a source of aqueous liquid thickener'. In particular, it is unclear if Appellant is referring to an 'aqueous liquid' (see specification paragraph [0079]), an 'aqueous based beverage' (see specification paragraph [0016]), a 'liquid aqueous food' (see specification paragraph [0029]), or the soluble food fiber thickeners of claim 42, for example.

Claim 41: The claim as written is ambiguous because of the phrase 'sufficient pressure drop'. In particular, it is unclear what pressure drop is necessary in order to obtain the desired results of the instant invention.

(10) Response to Argument

102 Rejection

APPELLANT'S ASSERTION

In summary, Appellant asserts that Wierlo does not anticipate the instant invention because the invention calls for a process of producing homogenous single phase thickened beverages suitable for consumption by a person suffering from dysphagia, the process comprising connecting a source of aqueous liquid thickener to a dispensing machine that is capable of dispensing non-thickened beverages. Appellant repeatedly sets forth that the cited prior art does not produce a beverage that is suitable for consumption by a person suffering from dysphagia. Appellant asserts that the product of Wierlo would not maintain bolus control since the thickness changes over time. Appellant emphasizes that the beverage must be suitable for consumption by a person suffering from dysphagia. It is Appellant's position that the phrase 'suitable for consumption by a person suffering from dysphagia' is a positive limitation that defines the physical characteristics of the beverage produced by the method, not merely an intended use for the beverage. Thus, the Examiner's reliance on MPEP 2111.02 is misplaced. In addition, it is asserted that Wierlo converts the liquid to a partial liquid, partially solid ice cream, frozen custard, milkshake, slush, ice, etc. Furthermore,

Appellant asserts that Wierlo does not connect anything to a dispenser that is capable of dispensing non-thickened beverages.

In regards to claim 40, Appellant asserts that Wierlo does not have a container of thickener concentrate, a switch which selectively controls whether or not the thickener concentrate is included in the beverage, and a metering pump.

In regard to claim 41, Appellant asserts that Wierlo does not have a container of thickener concentrate, a switch which selectively controls whether or not the thickener concentrate is included in the beverage, a metering pump, and a ready to drink substance with a homogenous appearance with the appropriate beverage thickness with or without the inclusion of the thickener concentrate.

EXAMINER'S RESPONSE

Appellant's response is non-persuasive for the following reasons. Wierlo discloses an apparatus for mixing thickened substances. The apparatus comprises a dispensing nozzle and a combination agitator-mixer-scraper. In addition, Wierlo discloses that unflavored substances such as ice cream, milkshakes, slush, ice, or frozen custard flows toward and exit nozzle the substance comes in contact flavored syrup (see entire document, especially, abstract; column 1, lines 6-13; column 2, lines 15-18). In Figure 1, a dispenser is disclosed. The dispenser includes an outer cabinet having located in the upper portion thereof a storage tank (column 2, lines 24-29). The dispensing machine of Wierlo is selectively dispenses a thickened food (ice cream, frozen custard, milkshake, etc.) into the dispensing nozzle (abstract; column 3, lines 16-35). In the detailed description of the drawings, the details of the apparatus disclose

that the dispense machine comprises a compressor motor, various storage tank, and optionally, a pump (column 2, lines 24-46). The dispensing machine has a switch mechanism to allow the operator to regulate the amount of food product being dispensed. Thus, both Applicant and Wierlo disclose a process for the production of a homogenous single phase thickened beverage comprising connecting a thickener to a dispensing machine and a switch mechanism for controlling the amount of thickener present.

Appellant's independent claim 39 is directed to a process comprising connecting a source of aqueous liquid thickener to a dispensing machine. Thus, the intended use for generating the thickened beverage (to be administered to someone with dysphagia) is not the basis upon which patentability is determined since by giving weight to the intended use of the claims, inappropriate claim interpretation occurs. Inappropriately reading limitations into the claims narrows the scope of claims. Such improper claim interpretation affects the way the claims are searched and what art is found and applied. Specifically, according to MPEP 2111.02, Section II, it is disclosed that the claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitation or mere statements of purpose or use are resolved only on review of the entirety of the record to gain an understanding of what is being claimed. Furthermore, MPEP 2111.02 discloses that if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention and the preamble merely discloses the intended use/purpose of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not

considered a limitation and is of no significance to the claim construction (*Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F. 3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Circ. 1999)). In this particular application, the entire claim was considered and it was found determined that the body of the claim fully and intrinsically sets forth all the limitations of the claims and the preamble merely states the intended use of the homogeneous single phase thickened beverage. Thus, the claim was interpreted as a process of producing a homogenous single phase thickened beverage wherein the process comprises connecting a source of liquid thickener to a dispensing machine that is capable of dispensing non-thickened beverages.

Furthermore, in response to Appellant's argument that the cited prior art is not suitable for dysphagia or capable of dispensing a non-thickened beverage, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

103 Rejection

APPELLANT'S ASSERTION

In summary, Appellant asserts that that there is no suggestion or teaching in Appellant's commercial individual packets of aqueous liquid thickener or in Uzuhashi (who discloses a somewhat similar individually packaged thickener) that the packets could somehow be connected to a beverage dispenser. In addition, it is asserted that there is

no hint in Wierlo that his apparatus may be modified to attach a source of aqueous liquid thickener and dispense beverages suitable for consumption by a person suffering from dysphagia. Also, it is asserted that the details disclosed in claims 41-45 are not disclosed by the cited prior art.

Appellant sets forth that their assignee sold packets of aqueous thickener concentrate in accordance with the disclosure of its US Patent application 10/485,879 more than one year before the effective filing date of the instant invention. The individual packets of thickener concentrate were intended to be mixed with a single serving of liquid food or beverage to make the food or beverage suitable for consumption by a person suffering from dysphagia. Furthermore, it is asserted that (1) the Examiner cannot pick and choose portions of a reference to support a given position; (2) the Examiner has not established a prima facie case of obviousness; (3) the Examiner has not resolved the level of ordinary skill in the pertinent art; (4) the Examiner's rationale for combining the references does not result in the instant invention; (5) there is no reasonable expectation of success that modifying the dispensing machine of Wierlo in view of Appellant's admission and Uzuhashi would successfully produce Appellant's process; and (6) the references alone or in combination do not teach or suggest all the claim elements.

EXAMINER'S RESPONSE

As stated in the previous response to the 102 rejection and summarized as follows. MPEP 2111.02 discloses that if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention and the preamble merely discloses the intended

use/purpose of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to the claim construction (Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F. 3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Circ. 1999)). In this particular application, the entire claim was considered and it was found determined that the body of the claim fully and intrinsically sets forth all the limitations of the claims and the preamble merely states the intended use of the homogeneous single phase thickened beverage. Thus, the claim was interpreted as a process of producing a homogenous single phase thickened beverage wherein the process comprises connecting a source of liquid thickener to a dispensing machine that is capable of dispensing non-thickened beverages. Likewise, it is noted that Appellant's assertion that the cited prior art is not suitable for dysphagia or capable of dispensing a non-thickened beverage must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. However, in this instance since both the prior art and the cited prior art disclose a process of producing a homogeneous single phase thickened beverage the prior art structure is capable of performing the intended use. As a result, the claim limitations are met.

In Appellant's response, it is noted that Appellant recognizes that Uzuhashi et al discloses a somewhat similar individually packaged thickener to Appellant's. In addition, Uzuhashi et al is directed to a liquid additive thickener or a liquid thickening agent that can thicken easily when it is added to an object. The liquid additive comprises a liquid that is prepared by dissolving a thickening agent into water (see

Uzuhashi et al abstract). The thickening agents may be added to foods and used with persons having mastication (the process of chewing food for swallowing) and deglutition (the act of swallowing) difficulties. It is preferable that the liquid additive thickener is separated and contained individually in a portion container or a small bag (column 1, lines 6-15; column 2, lines 45-65; columns 6-7, bridging paragraph; column 7, lines 20-38).

In regards to Appellant's other assertions, it should be noted that the Examiner did not pick and choose portions of the reference to support a given position. The cited prior art discloses a process of preparing a homogenous single phase thickened beverage. In addition, the prior art (i.e., Uzuhashi et al) discloses the motivation for using an aqueous liquid thickener. Thus, it is the Examiner's position that the prior art renders obvious the instant invention. Likewise, it is believed that the skill level of the artisan has been established.

The rationale for combining the references are believed to result in the instant invention since the cited prior art documents both disclose thickened beverages and the secondary reference, for example, provides motivation for using an aqueous liquid thickener and the use of such thickeners with person having mastication and deglutition difficulties. Furthermore, there is a reasonable expectation of such from the combination of references because according to MPEP 2143.02, a rationale to support a conclusion that a claim would have been obvious is appropriate if the claimed element are known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

combination would have yielded nothing more than predictable results to one of ordinary skill in the art. In this particular instance, the process of making a homogenous single phase thickened beverage is known, thickened beverages are known in the art, apparatus for connecting the source thickener are known in the art, and the advantages of using an aqueous liquid thickener are known in the art. Thus, a skilled practitioner in the art would expect that modifying the dispensing machine of Wierlo in view of Appellant's admission and Uzuhashi would successfully produce the instant invention. Hence, it is believed that the references render obvious the instant invention.

112 First Paragraph Rejections

APPELLANT'S ASSERTION

In summary, Appellant asserts that a skilled artisan would instantly recognize that the term 'aqueous liquid thickener' means a thickener having a liquid water base. In addition, it is asserted that aqueous liquid thickeners are described throughout the specification (i.e., paragraph [0054]) and that the phrase 'thickener concentrate' has been used since the application was filed. In regards to claim 39, Appellant asserts that the phrase 'liquid aqueous thickener' would be plainly understood by those skilled in the art to mean a water-based liquid thickener concentrate containing sufficient thickener.

In regards to claims 44 and 45, Appellant asserts that the Examiner provided no citation of authority when it was stated that one cannot arbitrarily select endpoints. Appellant's position is that the current range is narrower than that in the specification and one could easily derive the claimed ranges from the specification.

EXAMINER'S RESPONSE

When the claims were amended to read an 'aqueous liquid thickener', the Examiner indicated that new matter was incorporated into the claims because the phrase is not set forth in the disclosure and it was not clear if Appellant was actually referring to an 'aqueous liquid' (see paragraph [0079]), an 'aqueous based beverage' (see paragraph [0016]), or a 'liquid aqueous food' (see paragraph [0029]). Appellant references paragraph [0054] in specification as describing an aqueous liquid thickener. Specifically, it is disclosed that the sentence 'in an aspect, a sufficient quantity of thickener powder for the concentrate thickener being prepared is mixed with water in a suitable mixing vessel' provides support for 'aqueous liquid thickener'. The paragraph indicates that a thickener powder is mixed with water. However, 'an aqueous liquid thickener' is interpreted as a 'liquid', not powder thickener that is water-based. But, the phrases 'aqueous liquid' (see paragraph [0079]), an 'aqueous based beverage' (see paragraph [0016]), and 'liquid aqueous food', all of which appear in the disclosure are not necessarily referring to Applicant's thickener. Hence, the terms do not support the phrase 'an aqueous liquid thickener'. Furthermore, reference to an embodiment directed to a powder thickener do not support claim language directed to a liquid thickener. Thus, the claims were indicated as containing new matter and lacking written description because the specification does not provide support or a written description of the phrase.

In regards to claims 44 and 45 containing new matter because review of the specification does not set for the endpoints of the ranges appearing in the claims as amended. The Examiner reminded Appellant reminded that one cannot neither arbitrarily select endpoints from a range disclosed in the specification nor create a range. Specifically, in claim 44, and endpoint of 1% is not disclosed in the specification. In regards to claim 45, the range 0.3% and 1% of the beverage are not set forth in the disclosure. Appellant indicated that the Examiner has not provided any citation of authority for the statement.

The Examiner's statements are supported by the teachings of MPEP 2131.03 that deal with ranges. While that particular section of the MPEP refers to the prior art, the same logic is used when evaluating support for claims wherein ranges are modified. In Appellant's case, there were no specific examples establishing the particular amended endpoints. The Examiner reviewed what would constitute a 'sufficient specificity' of an endpoint. Claim 44 originally read on a range between 0.0005% and 10% of the thickener concentrate. Claim 45 original read on a range between 0.05% and 5% of the thickener concentrate. The amending of the claims to read between **1%** and 10% and **0.3%** and **1%** of the thickener concentrate, respectively, did not result in endpoints that one could clear envisage from within the range originally set forth in the disclosure or endpoints that were specifically disclosed in examples. Hence, since evidence in the disclosure did not support the amended of the claims to the specific endpoints, the claims were rejected for containing new matter.

112 Second Paragraph Rejections

APPELLANT'S ASSERTION

In summary, Appellant asserts that there is nothing ambiguous about the phrase 'aqueous liquid thickener' since the term would be understood by those skilled in the art to mean a water-based liquid thickener concentrate containing sufficient thickener.

In regards to claim 41 and the phrase, Appellant asserts that the claims spells out exactly what determines a sufficient pressure drop. A sufficient pressure drop is attained when the beverage exits the dispenser at the correct thickness with a homogeneous appearance and is ready to drink whether the beverage thickness is increased by inclusion of the thickener concentrate or not.

EXAMINER'S RESPONSE

The Examiner made the 112 second paragraph rejection over the claims because it was unclear whether or not Appellant was actually referring to a 'liquid' thickener or if reference was being made to an 'aqueous liquid' (see specification paragraph [0079]), an 'aqueous based beverage' (see specification paragraph [0016]), a 'liquid aqueous food' (see specification paragraph [0029]), or the soluble food fiber thickeners of claim 42. The Examiner could not ascertain what was being claimed since the phrase 'aqueous liquid thickener' is not present in the disclosure. The phrase is still ambiguous because in Appellant's response to the Examiner's 112 first paragraph rejection about the phrase, Appellant asserts that a skilled artisan would instantly recognize that the term 'aqueous liquid thickener' means a thickener having a liquid water base and cites paragraph [0054] in specification for support. However, paragraph

[0054] is directed to a powder, not liquid, thickener mixed with water. So, one of ordinary skill in the art would not know that Appellant is meaning the phrase to mean a water based liquid thickener concentrate when Appellant refers to a section of the disclosure that references a powder.

In response to Appellant's assertion that the claims explain exactly what is a sufficient pressure drop, a skilled artisan would not be able to ascertain what pressure drop Appellant is referring to because one would not know from the claim language how Appellant is defining or the limitations that indicate whether the correct thickness of the homogeneous beverage is reached or not. In addition, a skilled artisan would not know what conditions are being applied by Appellant to establish whether or not the beverage is ready for drinking or not. For example, what one person considers to be a 'thickened' beverage may or may not be will vary from person to person since the beverage may not have reached a maximum thickness. As a result, without some guidelines, a person of ordinary skill in the art would not know what is being claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/D. L. Jones/

Primary Examiner, Art Unit 1618

Art Unit: 1618

Conferees:

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1627

